

Applicant: Budzyn
Application No: 10/695,217
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REMARKS

Reconsideration of this application is respectfully requested.

Claims 1-16 are in the application.

In the Official Action, the Examiner rejected claims 1-16 under 35 U.S.C. §103(a) as being allegedly unpatentable over Lee (U.S. Patent No. 6,694,331) in view of Ooishi (U.S. Patent Application Publication No. 2002/0147793). The Examiner admitted that "Lee does not explicitly teach a method wherein the second search is performed without input from the user." The Examiner relied on Ooishi for allegedly overcoming this deficiency.

The Examiner's assertions are respectfully traversed. As set forth below, Lee relies on user involvement to determine the search criteria in establishing relevancy prior to ultimate searching. As such, user involvement is required in Lee, and Lee cannot be modified to avoid such user involvement.

In particular, at col. 11, ll. 37-39, and at col. 12, ll. 19-29, Lee discusses generating query information for review by a user for later searching. These excerpts refer to the Field-of-Search Module 314. As stated at col. 11, ll. 17-21,

A user presented with a list of such information (or other useable output) from *Field-of-Search Module 314* may use the list as an aid in determining, preparing, formulating, or otherwise creating *a field-of-search* (or any other practical use).

The created “field-of-search” is provided to the user for review.

The passage at col. 11, ll. 37-39 relied states: “Field-of-Search Module 314 may automatically (or manually) create, add, or suggest such search information (e.g., classes and subclasses) for a field-of-search.” This passage refers to the processing conducted by the Field-of-Search Module 314 in preparing a field-of-search. As discussed below, however produced, the resulting field-of-search will be provided to the user prior to execution. Thus, whether portions of the field-of-search are suggested or automatically generated, the field-of-search is still reviewed by a user before use.

With reference to col. 11, l. 63 – col. 12, l. 29, a method of creating a field-of-search by the Field-of-Search Module 314 is set forth. Step 708 of the method is described as: “***The search information may be displayed or otherwise output for viewing by the user to assist in the creation of a field-of-search***”. Figure 5 calls Step 708: “CREATE FIELD-OF-SEARCH”. As shown in Figure 5, Step 709 may be optionally added which adds information to the information delivered to the user in Step 708. Step 709 is described at col. 12, 19 – 26 and includes the notion of “automatically generating, adding, or suggesting a field-of-search” (col. 12, ll. 19-22). It is clear that from a reading of Lee and Figure 5, the field-of-search generated by the Field-of-Search Module 314 (however generated thereby) is delivered to the user for review in creating a field-of-search.

At col. 12, ll. 26-29, Lee discusses automatic execution of the field-of-search is disclosed after generation of the field-of-search. The passage states: "As used in a search system, as one example, *the field-of-search thus created* can form (or be part of) a search query or criteria to be executed by a local or remote database." This passage follows a description of Steps 708 and 709 discussed above. It is clear that a field-of-search created by that method is referred to in the passage — i.e., a field-of-search that involves user review prior to execution. Once a field-of-search is created by a user, the user can utilize a local or remote database to execute it in accordance with col. 12, ll. 26-29.

In the Official Action, the Examiner stated that Lee "does not explicitly teach a method wherein the second search is performed without input from the user." Although this statement is true, it must be noted that Lee *does explicitly teach* having user input. Lee is not silent on user input.

The Examiner proposed a hypothetical combination of Lee and Ooishi in which Lee is modified to have user input. However, with reference to MPEP §2143.01(VI), a reference cannot be modified in an obviousness rejection to change its principle of operation. This notion is separate and apart from any basis that can be relied upon from *KSR* in allowing for references to be combined. As stated at MPEP §2143.01(VI), "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." As set forth above, Lee relies on user involvement. Lee is not silent on user involvement and

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cannot be modified to avoid user involvement. It is respectfully submitted that Lee and Ooishi cannot be combined as suggested by the Examiner. Accordingly, it is respectfully submitted that the rejection of Lee and Ooishi be withdrawn.

Favorable action is earnestly solicited. If there are any questions or if additional information is required, the Examiner is respectfully requested to contact Applicant at the number listed below.

Respectfully submitted,

/Ludomir A. Budzyn/
Ludomir A. Budzyn
Reg. No. 40,540
Applicant

7 Edgewood Place
Maplewood, New Jersey 07040
(973) 763-1798